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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/762,648 | 01/10/2002 | Kevin A. Jarrell | 0342941-0045+0031 | 6754 |

7590

05/04/2004

Choate Hall & Stewart
Exchange Place
53 State Street
Boston, MA 02109

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| EXAMINER |
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MARVICH, MARIA

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| ART UNIT | PAPER NUMBER |
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1636

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DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,648

Applicant(s)

JARRELL ET AL.

Examiner

Maria B Marvich, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

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DETAILED ACTION

Claims 1-36 are pending in this application and subject to the following restriction.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-10, 12-23 and 30, drawn to a transcriptional regulator comprised of RNA that increases transcription.

Group II, claims 1-9, 11-23 and 30, drawn to a transcriptional regulator comprised of RNA that decreases transcription.

Group III, claims 24-29, drawn to a method of identifying a RNA regulator.

Group IV, claim 31, drawn to a method of treating an individual suffering from a disorder by administration of an RNA molecule.

Group V, claims 32-35, drawn to a method of identifying a target RNA that interacts with a test polypeptide.

Group VI, claim 36, drawn to an RNA linker molecule.

PCT Rule 13.2 requires that unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. The inventions listed as Group I-VI do not related to a single general inventive concept because they lack the same or corresponding technical feature. The "special technical feature" of Group I is a transcriptional regulator comprised of RNA, which is shown by Noonberg and Hunt et al. US 5,624,803 (see

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e.g. Figure 11B), to lack novelty of inventive step and does not make a contribution over the prior art.

MPEP 1875.01(d) states “If multiple products, processes of manufacture or uses are claimed, the first invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c).” As the “special technical feature” of Group I-VI, a transcriptional regulator comprised of RNA, lacks novelty, the inventions of Group I-VI do not form a single general inventive concept and instead are composed of the following inventions. The technical feature of Group I is drawn to an RNA transcriptional regulator that increases transcription. The technical feature of Group II is drawn to an RNA transcriptional regulator that decreases transcription. The technical feature of group III is drawn to a method of identifying RNA molecules that are transcriptional regulators. The technical feature of Group IV is drawn to a method of identifying a target RNA that interacts with a test polypeptide. The technical feature of Group V is drawn to a method of identifying a target RNA that interacts with a test polypeptide. The technical feature of Group VI is drawn to an RNA linker molecule.

Applicant is reminded that upon cancellation of claims to a non-elected inventions, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Conclusion

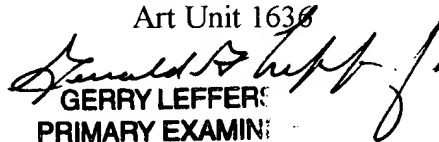
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (703) 605-1207. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 23, 2004

Maria B Marvich, PhD
Examiner
Art Unit 1636


GERRY LEFFER
PRIMARY EXAMINER